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| 09/611,548      | 07/07/2000  | DOUGLAS G. LOWENSTEIN | 114595-2-Polest     | 6763             |

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THE LAW OFFICE OF DONNA L. ANGOTTI  
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SUITE 4600  
NEW YORK, NY 10005

| EXAMINER |
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SUBRAMANIAN, NARAYANSWAMY

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**MAY 26 2011**

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NEW YORK NY 10005

|                              |   |                      |
|------------------------------|---|----------------------|
| In re Application of         | : |                      |
| Douglas G. LOWENSTEIN et al. | : |                      |
| Application No. 09/611,548   | : | DECISION ON PETITION |
| Filed: July 7, 2000          | : | UNDER 37 CFR 1.181   |
| For: FINANCING OF TENANT     | : |                      |
| IMPROVEMENTS                 | : |                      |

This is in response to applicants' petition, which is considered to be proper under 37 CFR 1.181, filed August 23, 2010 requesting withdrawal of the Office action of February 19, 2010 and refund of the petition and extension of time fees.

The petition is **GRANTED IN PART**.

The record reveals that after the issuance of the final Office action on October 3, 2008, applicants filed an amendment after final on March 4, 2009, and a notice of appeal along with a request for a pre-appeal conference on April 3, 2009. An advisory action was issued on May 5, 2009 along with a decision on the pre-appeal conference to proceed to Board of Patent Appeals and Interferences. The applicants filed a petition on July 6, 2009 to withdraw the restriction requirement made on January 10, 2008 and to vacate the final rejection mailed on October 3, 2008. Subsequently applicants filed a 200 page response on November 9, 2009 which included a reply to the October 3, 2008 Office action, a petition for extension of time, a conditional appeal brief, an affidavit by inventor Douglas Lowenstein, a Statement of Financial Accounting Standards No. 13 as exhibit 2, an OMB Memorandum M-07-07 titled "Final Bulletin for Agency Good Guidance Practices" dated January 18, 2007 as exhibit 3, and a copy of the July 6, 2009 petition as exhibit 4. In the claims appendix two starting on page 82 is a proposed amendment where applicants amended claims 1, 2, 56, 60, 74, 119, 126-130, 133, 140, 148, 154, 158, 161, 172, 180 and 181.

In response to applicants' July 6, 2009 petition, the examiner issued a non-final Office action on February 19, 2010 to open prosecution by withdrawing the restriction requirement made on January 10, 2008, vacating the final rejection mailed on October 3, 2008, and issuing a new Office action on claims 1-181. Applicants filed a petition on August 23, 2010 along with a response to the February 19, 2010 Office action. In the petition, applicants allege that the

February 19, 2010 Office action did not examine the latest amended claims presented in the Claims Appendix Two filed in the November 9, 2009 response. Applicants further argue that since the Office erred in not entering the amendments to the claims set forth in the Claims Appendix Two of November 9, 2009 and the examiner failed to examine the latest amended claims, the Office should refund the petition fee of \$400.00 and the extension of time fees of \$555.00.

A review of the February 19, 2011 Office action reveals that the first line of the action states that the Office action is in response to applicant's communication of November 9, 2009. However, a close review at the objections and rejections set forth in the Office action shows that the changes made in the claims by the November 9, 2009 amendment were not mentioned or addressed by the Office action. Therefore, applicants' request to withdraw the February 19, 2010 Office action is granted. A new Office action will be issued to treat the November 9, 2009 amendment.

MPEP 1002 and 37 CFR 1.181 regarding petitions to the Director states that

(a) *Petition may be taken to the Director:*

(1) *From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;*

(2) *In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and*

(3) *To invoke the supervisory authority of the Director in appropriate circumstances. For petitions in interferences, see § 1.644. <*

(b) *Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.*

(c) *When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.*

(d) *Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.*

It is noted that the August 23, 2010 petition is from an action of an examiner in the ex parte prosecution of an application, which meets the criteria set forth in 37 CFR 1.181 (a) (1). The instant petition is considered to be a petition filed under 37 CFR 1.181. As for the petition fee, it is noted that 37 CFR 1.17 (f) on patent application and reexamination processing fees shows no fee for petitions filed under 37 CFR 1.181. Therefore, the petition fee of \$400.00 will be refunded.

Regarding the extension of time fee, 37 CFR 1.136 (a) states that:

- (1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:*
  - (i) Applicant is notified otherwise in an Office action;*
  - (ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;*
  - (iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;*
  - (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.304 or to § 41.50 or § 41.52 of this title; or*
  - (v) The application is involved in a contested case ( § 41.101(a) of this title).*
- (2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings, § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences.*

It is noted that the nonstatutory response period for the February 19, 2010 Office action expired on May 19, 2010. Applicants submitted an amendment as a response on August 23, 2010 which is 3 month after the nonstatutory response period has expired. Regardless of whether the February 19, 2010 Office action is proper, applicants' response is still required. An extension of time would be needed in order too make the August 23, 2010 response timely. Without an extension of time, the amendment dated August 23, 2010 would be held "untimely" and would not be entered. Therefore, applicant's request for a refund of the extension of time fee is denied.

It is noted that following the filing of a request for reconsideration and argument on August 23, 2010 in response to the February 9, 2010 Office action, applicants filed a supplemental amendment on November 5, 2010. MPEP 714.03(a) and 37 CFR 1.111 (a) (2) regarding supplemental replies indicates that:

- A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:*
- (A) Cancellation of a claim(s);*
  - (B) Adoption of the examiner suggestion(s);*
  - (C) Placement of the application in condition for allowance;*

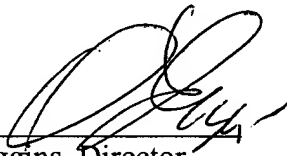
- (D) *Reply to an Office requirement made after the first reply was filed;*
- (E) *Correction of informalities ( e.g., typographical errors); or*
- (F) *Simplification of issues for appeal.*

(ii) *A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).*

*When a supplemental reply is filed in sufficient time to be entered into the application before the examiner considers the prior reply, the examiner may approve the entry of the supplemental reply if, after a cursory review, the examiner determines that the supplemental reply is limited to one of the situations set forth above. This list is not exhaustive. The examiner has the discretion to approve the entry of a supplemental reply that is not listed above.*

Based on the guidance set forth in MPEP 714.03(a) and 37 CFR 1.111 (a) (2), entry of the supplemental amendment filed on November 5, 2011 will be decided by the examiner. The examiner will notify the applicants in the subsequent Office action whether the supplemental reply is approved for entry. If entered, the supplemental amendment would supersede the amendment dated November 9, 2009.

Any questions regarding this decision should be directed to Quality Assurance Specialist Lanna Mai at (571) 272-6867.



Wynn W. Coggins, Director  
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(571) 272-5350

lm: 5/23/11